

Application No. 10/081,674
Amendment dated March 21, 2005
Reply to Office Action of January 10, 2005

REMARKS/ARGUMENTS

Responsive to the Official Action mailed January 10, 2005, applicants have amended the claims of their application in an earnest effort to place this case in condition for allowance. Specifically, claims 1, 18, and 24 have been amended. Reconsideration is respectfully requested.

Applicants wish to gratefully acknowledge the Examiner's allowance of claims 16 and 23. By this Response, claim 9, indicated as being allowable, has been canceled, and the limitations thereof added to independent claim 1. Claim 18 has also been amended. Accordingly, it is believed that claim 1, the claims depending therefrom, and claim 18, are now in condition for allowance.

In the Action, the Examiner objected to the language in claim 24 specifying its dependency from claim 14. Upon review of this claim, it will be appreciated that claim 24 is intended to depend from method claim 23, and claim 24 has been revised accordingly. It is believed that claim 24 is also now in condition for formal allowance.

In the Action, the Examiner rejected claims 12-15 under 35 U.S.C. §112, noting that these claims depend from claim 1, which specifies that the present protective cover "consists of" spunbond, thermoplastic polymeric filamentary elements. However, this rejection is respectfully traversed, since claims 12-15 *add no new elements* to those filamentary elements of which the claimed nonwoven fabric is stated as "consisting of". Rather, these dependent claims merely further specify the nature of the recited

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polymeric filamentary elements, but again, *do not recite any* additional elements from which the fabric is formed other than filamentary elements.

Applicants refer to M.P.E.P. Section 2111.03 referenced by the Examiner, and in particular, *Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc.*, 793 F.2d. 1279 (Fed. Cir. 1986). As noted in the M.P.E.P., "a claim which depends from a claim which 'consists of' the recited elements, or steps, *cannot add an element or step*".

In the present case, claims 12-15 *do not add an element or step*. Rather, these claims merely specify the nature of the recited polymeric filamentary elements.

Applicants respectfully request reconsideration of this rejection. Should the Examiner maintain this rejection, this would improperly suggest to a potential infringer that infringement of claim 1, as amended, is avoided by merely incorporating one of the recited protection-enhancing agents in the polymeric melt, or by topical application to the filaments, thus denying applicants' scope of protection commensurate with their disclosure and claims. It is not believed that the Office intends to limit applicants' protection in this fashion, since applicants have otherwise distinguished their claimed construct from the prior art by specifying that the fabric *consists of* spunbond, thermoplastic polymeric filamentary elements.

In the event that the Examiner maintains his rejection of claims 12-15, the Examiner is respectfully requested to contact the undersigned attorney, to see if alternative claim language might be agreed upon. Again, applicants must respectfully

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voice their concern that by maintaining this rejection, or by cancellation of these claims, potential infringers are all but invited to circumvent the scope of protection, which it is believed the Office intends to grant, by the mere addition of a performance-enhancing additive to the polymer from which the claimed polymeric elements are formed.

In view of the foregoing, formal allowance of claims 1, 8, 12-15, 16, 18, and 23-24 is believed to be in order and is respectfully solicited. Should the Examiner wish to speak with applicants' attorneys, they may be reached at the number indicated below.

The Commissioner is hereby authorized to charge any additional fees which may be required in connection with this submission to Deposit Account No. 23-0785.

Respectfully submitted,

By 
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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage at First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on **March 21, 2005**.

